

Docket No. 10008180-1

**Remarks**

This Amendment is responsive to the January 9, 2006 Office Action. Reexamination and reconsideration of claims 1-3, 5-12, 14-26, and 28-30 is respectfully requested.

**Summary of The Office Action**

Claims 1-3, 9, 11, 12, 14-18 and 26 were rejected under 35 U.S.C. §102(e) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Davis et al. (US 2002/0059489).

Claims 5-8, 13, and 19-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Davis as applied to claim 1 above, and further in view of Okigami (US 6,788,427).

Claim 10 was rejected under 35 U.S.C. §103(a) as being unpatentable over Davis in view of Yamada (US 2002/0010806).

Claims 27-30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Davis et al. in view of Dutta (US 6,891,635).

**Present Amendment**

Claim 1 has been amended with language that is supported by, for example, claim 30 and/or page 2, lines 18-23 (paragraph [0007]) of the present specification. Thus, no new matter has been added.

Claim 11 has been amended with language that is supported by, for example, page 10, lines 1-4 and/or page 26, lines 15-22 of the present specification. Thus, no new matter has been added.

Independent claim 13 has been cancelled.

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Dependent claim 30 has been rewritten in independent form. Thus, parent claim 27 has been cancelled.

**Provisional Application of Davis Patent Does Not Support Subject Matter**

Applicant respectfully repeats, as in the previous response, that the provisional application of Davis does not disclose or support the subject matter of various teachings that are used to reject the present claims. Therefore, for the subject matter that is not disclosed in the provisional application, Davis does not qualify as prior art since its filing date is after the filing date of the present application.

For example, Davis is applied to teach the limitation of claim 1 of “wherein a printer driver for the printing is not installed on the client computing device”. Other claims include similar language. Applicant has reviewed the provisional application and it fails to disclose a feature where a printer driver is not installed on the client device. Therefore, Davis does not qualify as prior art as to this teaching. Thus, Davis does not support the rejection and the rejection must be withdrawn.

**The Claims Patentably Distinguish Over the References**

Claim 1 recites where the one or more print options are automatically selected based at least in part on one or more characteristics of the request and based on a user print history that includes previous print option selections. Davis and Okigami both fail to teach or suggest this feature and thus claim 1 patentably distinguishes over the references of record.

Dependent claim 30, which recites a feature relating to user print history, was rejected as being obvious over Davis et al. in view of Dutta (US 6,891,635). Applicant will address this rejection since presumably it will be applied against claim 1. The Office Action on page 17, paragraph 46, states that Dutta teaches automatically selecting print options based on a user print

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history. Column 3, lines 65-67 to column 4, lines 1-16 of Dutta is cited as teaching this feature. Applicant has reviewed this section and respectfully submits that Dutta does not teach automatic selection of print options based on a user print history as discussed by the following.

Dutta, column 3, lines 65-67 to column 4, lines 1-16 are reproduced here with Applicant's comments in brackets [ ] :

"Document content type determiner 230 is software for determining the type of document being printed based on keywords found in the document or other attributes of the document (i.e., website from which the document was downloaded, document titles, etc.)." [No mention of automatic selection of print options or print history]

"Document content type determiner also includes the type of file being printed, such as a spreadsheet, a word processing document, or a web page. User type determiner software 235 determines the type of user that is printing a document (i.e., a doctor, an engineer, an accountant, etc.)." [No mention of automatic selection of print options or print history]

"This information can be gathered using interactive software that requests the information from the print user before a document is accepted for printing." (Dutta, column 4, lines 7-10). [No mention of automatic selection of print options or print history. In fact, this information is gather from the user and thus is not automatic.]

"Advertisement mapping table 240 is an electronic table including advertisement names (i.e., file names or other advertisement identifier) and the types of documents and users that are the target audience for the advertisement. The advertising mapping table may also keep track of the number of times each advertisement has been included in a printout." (Dutta, column 4, lines 10-16). [No mention of automatic selection of print options or print history. Tracking the number of times an advertisement has been included is not a user print history.]

Therefore, Dutta fails to teach or suggest automatic selection of print options based on a user print history as recited in claim 1, and fails to cure the shortcomings of Davis. Since claim 1 recites features not disclosed or suggested by the references, alone or in combination, claim 1 patentably distinguishes over references of record and is now in condition for allowance. Accordingly, dependent claims 2-3 and 5-10 also patentably distinguish over the references and are in condition for allowance.

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**Independent Claim 11**

Claim 11 recites subsequently receiving a print request without print options and automatically selecting a set of print options from the user-selected print options to print a document identified in the print request, wherein the set of print options are automatically selected based at least in part on one or more characteristics of the print request.

Davis teaches print parameters that are included with a print job, not a print job without print parameters (see Davis claim 12, or paragraph [0037]: “the print job comprises document data and printing parameters.”, or paragraph [0025]: “...application 42 sends the document to file manager 44 with specific destination printer and print option information.”). Thus, Davis operates by providing print options with a print job. Davis discloses nothing to the contrary that would indicate that a print job has no print options. Furthermore, Davis fails to consider how it would process a print job without print options because that is not the purpose of Davis. Therefore, one of ordinary skill in the art would not find it obvious to automatically select print options when no print options are present with the print request since Davis teaches sending print parameters or print options with the print job. Thus, Davis fails to support a proper obviousness rejection.

Since claim 11 recites features not disclosed or suggested by the references, claim 11 patentably distinguishes over the references and is not obvious in light of the references. Accordingly, dependent claim 12 also patentably distinguishes over the reference, is not obvious in light of the reference, and is in condition for allowance.

**Independent Claim 14**

Claim 14 recites accessing a location other than the client computing device to obtain the identified collection of printer configuration options. The Office Action states that Davis teaches

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this feature however no citation to Davis is provided. Applicant respectfully submits that Davis fails to teach or suggest this claimed feature and thus fails to support the rejection.

For example, Davis states that "print option information" is sent by the application 42 (see Davis, bottom of paragraph [0025]). There is no explanation of what this print option information is but there is also no teaching of obtaining printer options by accessing a location other than the client computing device as recited in claim 14. Furthermore as explained with reference to claim 11, Davis provides print options with the print job and thus the print options are not obtained by accessing a location as claimed. Therefore, Davis fails to support the rejection and fails to teach or suggest the method of claim 14. Claim 14 thus patentably distinguishes over the references of record and is in condition for allowance.

#### **Independent Claim 15**

The Office Action rejects Claim 15 based on Davis and states that:

"It would be obvious to one skilled in the art at the time of the invention that the print options sent by the user via the remote computer would have to be automatically interpreted/recognized by the remote printer in order for the print job to be successfully outputted." (Office Action, top of page 9) [emphasis added]

Applicant respectfully submits that the purpose of method claim 15 is to process print requests when a user does not send print options with the print request. Rather, the print options are automatically selected based on characteristics of the request, which is recited in the claim. Davis teaches print parameters that are included with a print job (see Davis claim 12, or paragraph [0037]: "the print job comprises document data and printing parameters.", or paragraph [0025]: "...application 42 sends the document to file manager 44 with specific destination printer and print option information."). Therefore, one of ordinary skill in the art would not find it obvious to automatically select print options when no print options are present with the print request since Davis teaches sending print parameters or print options with the print job. Thus, Davis fails to support a proper obviousness rejection.

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Furthermore, the present specification clearly explains the method of claim 15 and clearly differentiates between "print options" and "characteristics" of a print request. The Federal Circuit has held that the specification is the best source for interpreting claim terms, not a dictionary or other external source. When properly interpreting claim 15, Davis and the other references fail to teach or suggest the recited features. Thus the references fails to support the rejection and the rejection should be withdrawn.

As such, Claim 15 patentably distinguishes over the reference and is in condition for allowance. Accordingly dependent claims 16-26 also patentably distinguish over the references, are not obvious in light of the references, and are in condition for allowance since they depend from claim 15.

**Dependent Claim 16**

Claim 16 depends from claim 15 and has been amended to recite that the automatic selection is also based on a user print history. Based on the explanations provided with reference to claim 1 and a user print history, the references even when combined fail to teach or suggest such a feature. Thus, claim 16 patentably distinguishes over the references of record for this additional reason.

**Independent Claim 30**

Claim 30 has been rewritten into independent form.

Claim 30 was rejected as being obvious over Davis et al. in view of Dutta. Applicant refers to the explanations of Dutta provided above with reference to claim 1. Dutta fails to teach or suggest an auto-select module that automatically selects print options based on a user print history as recited in claim 30, and thus fails to cure the shortcomings of Davis. Since claim 30 recites features not disclosed or suggested by the references, alone or in combination, claim 30 patentably distinguishes over references of record and is now in condition for allowance.

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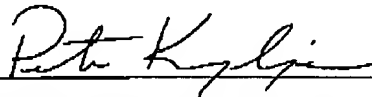
Accordingly dependent claims 28-29 also patentably distinguish over the references, and are in condition.

**Conclusion**

For the reasons set forth above, claims 1-3, 5-12, 14-26, and 28-30 patentably and unobviously distinguish over the references of record and are now in condition for allowance. An early allowance of all claims is earnestly solicited.

Respectfully submitted,

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